

12/20/01

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Financial Engines, Inc.**

Serial No. 75/712,805
Serial No. 75/712,807

Lori M. Stockton, Michael W. Hicks and Thomas M. Coester of
Blakely Sokoloff Taylor & Zafman for **Financial Engines, Inc.**

Kathleen M. Vanston, Trademark Examining Attorney, Law Office
103 (Michael A. Hamilton, Managing Attorney).

Before **Quinn, Hohein** and **Drost**, Administrative Trademark
Judges.

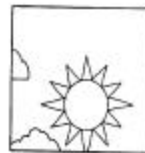
Opinion by Hohein, Administrative Trademark Judges:

Financial Engines, Inc. has filed applications to
register the miscellaneous designs, hereinafter referred to as
a stylized cloud design¹ and a stylized sun design,² as

¹ Ser. No. 75/712,
first use anywhere



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commerce of Dec



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² Ser. No. 75/712,
first use anywhere

l on May 24, 19
commerce of December 2, 1997.

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Ser. Nos. 75/712,805 and 75/712,807

respectively reproduced below,

for, in each instance, "financial services and interactive computer on-line services offered via a global computer network in the fields of financial planning, investment analysis, portfolio allocation and recommendations for selecting specific financial instruments."

Registration has been finally refused in each case under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127, on the ground that, as shown by the specimens of record in each application, which consist of reproductions of a graphical user interface utilized in the rendering of applicant's services, the stylized cloud design and the stylized sun design which applicant seeks to register do not function as service marks. Specifically, as stated in her final refusals, the Examining Attorney contends that such designs "[do] not function as a source indicator to the user" and that, instead, "the consumer will perceive ... [each of such designs] as a decorative graphics display to underscore the notion of [respectively] a 'cloudy financial forecast,' a term with a common meaning in the financial sector" and "a 'sunny financial forecast,' a term with a common meaning in the financial sector."

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Applicant, in each case, has appealed. While briefs have been filed in each instance, an oral hearing was not requested. Because the issues presented are essentially the same, the appeals have been treated in a single opinion. We affirm the refusals to register.

The specimens of record depict the following manners of use of applicant's stylized cloud design and stylized sun design:

Applicant, in support of its view that the specimens of record show that the designs which it seeks to register function as service marks, asserts by way of background that, as stated in each of its initial briefs:

Here, the Applicant has created a branding program for its financial services focused on an all-encompassing weather theme. In the present case, the mark is used, not only on Applicant's web page, but also on print advertisements for the applicant's financial services.

Besides making of record a copy of a portion of a brochure for its services in which appear, following the query "WHAT'S YOUR FINANCIAL FORECAST?," various weather-related icons (including the designs involved in these appeals) which are individually associated with the questions "cloudy?," "stormy?" and

"sunny?," applicant has made of record evidence indicating that it is the owner of two registrations and an intent-to-use application for certain other cloud and sun designs for the same services as those involved in these appeals as well as for printed materials regarding various financial services.³ Such evidence, applicant insists, demonstrates that the subject designs which it seeks to register are "used as part of an overreaching theme of various weather designs that consumers will recognize as indicating the source of the financial services at issue."

As to the supporting evidence (discussed in more detail hereinafter) presented by the Examining Attorney, applicant contends that such evidence is irrelevant to whether its subject designs function as service marks. Specifically, noting that neither its stylized cloud design nor its stylized sun design contains the words "FINANCIAL FORECAST," "CLOUDY

³ While the record does not reveal the file history of applicant's two registrations, and thus the manner of use of the marks as shown by the specimens therein is not disclosed, it is notable that the portion of the brochure furnished by applicant also shows, with respect to one of its registered cloud and sun designs, a manner of use thereof, as illustrated below, which is strikingly different from the usages shown by the specimens of record herein with respect to applicant's stylized cloud design and stylized sun design.

FINANCIAL FORECAST" or "SUNNY FINANCIAL FORECAST," applicant argues that:

[T]he Lexis-Nexis articles offered by the Examining Attorney, at most, simply refer to a company's financial forecast as being unclear or murky [or positive or cheerful]. Not one of these articles refer to weather or weather patterns. There is no direct connection between Applicant's stylized logo[s] of a sun and clouds and the services for which registration is sought
....

With respect to the web-page printouts submitted by the Examining Attorney, applicant urges that such "also do not reference any connection between cloud [or sun] designs or weather and financial services." While conceding that two of the three printouts "appear to offer general information relating to finance," applicant asserts that "they do not draw a connection between financial services and weather (much less a stylized [cloud or] sun design)" and thus are irrelevant to the issues of whether its stylized cloud design and stylized sun design function as service marks as shown in the specimens of use.

We agree with the Examining Attorney, however, that as shown on the specimens of record, applicant's stylized cloud design and its stylized sun design do not function as service marks for the services recited in the subject

applications. As correctly pointed out in each of her initial briefs:

To be registrable as a service mark, the record must indicate that the asserted mark actually identifies and distinguishes the recited service and indicates source. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973), aff'g 167 USPQ 245 (TTAB 1970). Whether a mark has been used in association with a particular service is a question of fact to be determined primarily on the basis of the specimens. *In re Advertising and Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989).

It is the perception of the ordinary customer which determines whether the asserted mark functions as a service mark, not the applicant's intent, hope or expectation that it do so. See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960). The public will not be expected to browse through a group of words, or scan an entire page, in order to determine whether a particular term, apart from its context, may be intended to serve as a mark. *Ex parte National Geographic Society*, 83 USPQ 260 (Comm'r Pats. 1949). See also *In re C.R. Anthony Co.*, 3 USPQ2d 1894 (TTAB 1987); *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982).

Among other things, the Examining Attorney argues that consumers for applicant's services are not likely to perceive applicant's stylized designs as anything other than decorative icons representing the financial prospects or

forecasts for various investment strategies.⁴ As is readily apparent from the specimens of use, applicant's stylized designs appear in windows immediately beneath the word "FORECAST." Although, as applicant notes, such word is not part of either of its stylized designs, it is part of the relevant context in which the designs appear. Such context, the Examining Attorney, urges, is significant because the word "forecast," while "a term used in discussing weather, is very often used in the financial sector as well."

In support thereof, the Examining Attorney observes that the record in each case contains excerpts, of which the following are representative, retrieved from a search of the "NEXIS" database which refer in general to "financial forecasts" (**emphasis added**):⁵

"[S]he will oversee cash management,
debt management, financings, investor

⁴ While the Examining Attorney also contends that applicant's designs do not function as service marks because they may not even appear when applicant's services are rendered, the issue before us is whether, when presented to customers for its services in the manner illustrated by the specimens of use, applicant's stylized cloud design and its stylized sun design will be recognized as indications of source or origin of its services and hence are registrable as service marks.

⁵ We have not given any consideration to the excerpts obtained from wire services since, as applicant properly notes in its objection thereto, "there is no evidence to show that these articles were ever published in the United States or viewed by U.S. consumers." See, e.g., In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1555 (TTAB 1987) at n. 6 and In re Men's Int'l Professional Tennis Council, 1 USPQ2d 1917, 1918-19 (TTAB 1986).

relations and **financial forecasts**." --
Atlanta Journal & Constitution, August 30,
2000;

"While **financial forecasts** suggest a
project for families with annual incomes
between \$30,000 and \$33,000 is feasible
...." -- Chapel Hill Herald, August 30,
2000;

"Using **financial forecasts**, the sales
executives help to ensure that any drug the
scientists are developing has a ready
market." -- NY Times, August 27, 2000; and

"Previous long-term **financial
forecasts** have predicted budget surpluses
of as much as \$16 million in fiscal 2003."
-- San Antonio Express-News, August 23,
2000.

Several web-page printouts likewise refer to the terms

"financial forecasts" or "financial forecast."

In addition, as evidence that "actual weather terms
are ... used often to indicate whether financial prospects are
good or bad" and that, in particular, "[r]eferences to clouds
often accompany reports of poor financial prospects," the
record in the case of applicant's stylized cloud design
application contains the following representative "NEXIS"
excerpts (**emphasis added**):

"The weather forecast is partly
cloudy, much like the **financial forecast**
for the University of Charleston crew team
that sponsors the annual Kanawha River
regatta." -- Charleston Daily Mail, April
23, 1999;

"She said Canton's five-year **financial forecast** is **cloudy**." -- Patriot Ledger (Quincy, MA), November 18, 1998;

"Since Yellow bought the struggling Caroline County company for \$23.9 million in 1992, Preston's **financial forecast** has been **cloudy**." -- Daily Record (Baltimore, MD), June 16, 1998;

"The **financial forecast** is at least partly **cloudy**." -- Telegram & Gazette (Worcester, MA), May 5, 1997; and

"[With] a solid season behind it and plans for a major capital campaign looming for 1997, Trinity's **financial forecast** remains **cloudy**." -- Providence Journal-Bulletin, December 29, 1966.

Similarly, as evidence that "[r]eferences to the sun often accompany good financial prospects," the record in applicant's stylized sun design application includes the following illustrative "NEXIS" excerpts (**emphasis added**):

"[The Continental] Basketball Association bringing a franchise to the Show Place Arena this fall has General Manager Bill Chambers seeing a **sunny financial forecast** for his building." -- Washington Post, June 22, 2000;

"Her **financial forecast** looks **sunny**." -- Washington Times, June 22, 2000;

"In fact, the **financial forecast** seemed **sunny**." -- Virginian Pilot (Norfolk, VA), March 9, 2000; and

"SURVEY: A majority of respondents predicts a **sunny** five-year **financial forecast**." -- Orange County Register, September 28, 1999 (article headlined: "O.C. views economy with confidence").

Thus, according to the Examining Attorney:

"Consumers are accustomed to seeing analogies between poor financial prospects and cloudy weather [and favorable financial forecasts and sunny weather]. Therefore, when members of the purchasing public come into contact with a cloud [or sun] icon, it [respectively] is likely to appear as nothing more than a decorative icon designed to invoke the widely referenced concept of a cloudy [or sunny] financial forecast.

We concur with the Examining Attorney that, when viewed in the context presented by the specimens of record, customers for applicant's financial services and interactive computer on-line services offered via a global computer network in the fields of financial planning, investment analysis, portfolio allocation and recommendations for selecting specific financial instruments would regard its stylized cloud design and stylized sun design simply as icons indicating that a particular scenario or strategy respectively presents a poor or cloudy financial forecast or a favorable or sunny financial forecast. Such designs would not be perceived as indicators of source or origin, given the fact that, in each instance, the respective designs appear as part of an on-line "FORECAST & ADVICE" screen or window which, as to "YOUR FUTURE," answers the customer's question of "What is the estimated chance I reach my goal ... ?" with a "FORECAST" of "<5%" superimposed over the stylized cloud design or ">95%"

appearing over the stylized sun design. Rather than functioning as service marks for applicant's services, such designs merely serve as graphical representations of a poor or cloudy financial forecast, in the case of applicant's stylized cloud design, or a favorable or sunny financial forecast, in the instance of applicant's stylized sun design.

Moreover, contrary to applicant's argument in each of its initial briefs that the "illustration of weather patterns, in the form of sun or cloud designs, used in connection with financial services is highly unusual," the evidence furnished by the Examining Attorney is sufficient to indicate that financial forecasts, like weather forecasts, commonly speak of sunny and cloudy forecasts. Customers for applicant's services would be familiar with such concepts and, upon seeing applicant's stylized designs in the context shown by the specimens of record, would treat such designs as icons which graphically display whether, in light of the consumer's particular risk decisions and selected investments, the likely outcome thereof offers a cloudy or sunny financial forecast. Accordingly, and notwithstanding that the record establishes that applicant utilizes another weather-themed design in its advertising brochure and has registered such design for the same services as those herein, the specimens of record in the applications before us fail to demonstrate that the stylized

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cloud design and stylized sun design which it seeks to register do in fact function as source indicators and thus serve as service marks for the services recited. See, e.g., In re Moody's Investors Service Inc., 13 USPQ2d 2043, 2048 (TTAB 1989) [specimens of record do not show use of designation "Aaa" as mark identifying services of providing ratings for fixed interest rate bonds since designation is merely one of many symbols used to indicate applicant's opinion of financial soundness of particular bond issues and is not used in specimens to identify services for which registration of such designation is sought].

Decision: The refusal to register is affirmed in each case.